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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,398	05/04/2006	Yasushi Washio	SHIGA7,049APC	1842
20995 7590 11/14/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
WALKE, AMANDA C				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
11/14/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

# Office Action Summary

**Application No.**

10/578,398

**Applicant(s)**

WASHIO ET AL.

**Examiner**

Amanda C. Walke

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/08 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, and 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori et al (EP762208).

Hattori et al disclose a light sensitive material comprising a binder resin, and initiator, and a polymerizable compound, as well as a solvent. Given the suitable monomers listed for the resin, one of ordinary skill in the art would have been motivated to employ monomers such as (meth)acrylic acid, hydroxyethyl(methacrylate) (instant formula(1)), and a functional (meth)acrylic compound (see pages 4 and 5, as well as polymers 1-3 and 10. One of ordinary skill in the art would have been motivated to choose cyclohexyl(meth)acrylate as a component of class (6) in the place of methyl (meth)actylate in polymer 10). The resultant polymer would meet

the instant claims limitations. The material is employed in a method of making a pattern including the steps of coating, drying/ pre-baking, exposed, and developed (see examples).

***Response to Arguments***

4. Applicant's arguments filed 10/28/08 have been fully considered but they are not persuasive. Applicant has again argued that the reference fails to teach the cyclic containing resin is present in the instantly claimed amount and that the examples in the instant specification demonstrate that unexpected and superior results are obtained by the instant invention and included the weight limitation of 65-75% in the newly added claim 9. The Examples of the specification of the reference teach that methyl methacrylate and ethyl methacrylate are present in the resin in amounts falling within the scope (70%, 85%) and that as in the list of monomers included as equivalent to these is a cyclic component as discussed above (component 7), thus that component is contemplated to be added in amounts falling within the instantly claimed range. Furthermore, the examiner has again considered the examples in the instant specification. The only samples include amounts of 35%, 40%, 65%, 71%, 73%, and 75%, missing are points just outside the low end of the range and up to the high end of the range and just outside, therefore the examples are unpersuasive. They would also be unpersuasive due to the fact that the samples all comprise the most preferred embodiment, dicyclopentanyl methacrylate (see page 5 of the instant specification for this teaching), thus the examples are not commensurate in scope with the instant claims. Therefore, the examiner maintains the rejection of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C. Walke whose telephone number is 571-272-1337. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amanda C Walke  
Primary Examiner  
Art Unit 1795

/Amanda C Walke/  
Primary Examiner, Art Unit 1795

**Application Number****Application/Control No.**

10/578,398

**Applicant(s)/Patent under  
Reexamination**

WASHIO ET AL.

**Examiner**

Amanda C. Walke

**Art Unit**

1795